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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                            |   |                             |
|----------------------------|---|-----------------------------|
| In re Application of:      | ) | Art Unit: 1634              |
|                            | ) |                             |
| H. UEMURA et al.           | ) | Examiner: A. K. Chakrabarti |
|                            | ) |                             |
| Appln. No.: 09/856,320     | ) | Washington, D.C.            |
|                            | ) |                             |
| Filed: May 21, 2001        | ) | November 4, 2002            |
|                            | ) |                             |
| For: NOVEL SERINE PROTEASE | ) | Atty. Docket: UEMURA=4      |
| BSSP6                      | ) |                             |
|                            | ) |                             |
| Confirmation No.: 6682     | ) |                             |

RESPONSE TO RESTRICTION REQUIREMENT

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Honorable Commissioner for Patents  
Washington, D.C. 20231

NOV 05 2002

TECH CENTER 1600/2900

Sir:

The Office Action of October 10, 2002, Paper No. 14, primarily in the nature of a requirement for restriction has been carefully reviewed.

The examiner considers the claims to be directed to six patentably distinct inventions and requires election of a single invention from, namely:

Group I, drawn to a protein, and presently comprising claims 1, 30, 31, 37-42, and 51;

Group II, drawn to a nucleic acid, and presently comprising claims 2, 20, 21 and 43;

Group III, drawn to a method of making protein, and presently comprising claims 22, 25, 32 and 44-47;

Group IV, drawn to a transgenic animal, and presently comprising claims 25-29;

Group V, drawn to an immunoassay, and presently comprising claims 33-36, 48, 49, 52 and 53; and

Group VI, drawn to screening of drugs, and presently comprising claim 50.

Applicants provisionally elect Group I, presently comprising claims 1, 30, 31 and 37-41, with traverse.

The examiner stated that the inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under Rule 13.2, they lack the same or corresponding special technical features for the following reason: a preliminary search revealed that a marker for diagnostic or prostatic hypertrophy in prostate of instant claim belonging to Group I has been disclosed by Dillon et al. (U.S. Patent No. 5,780,286).

The basis for traversal is that Dillon does not disclose a marker that is a serine protease according to the present invention but rather discloses a marker that is an arginase. Thus, citation of an arginase as a marker does not defeat the special technical feature of the present invention, which is a protein that is a specific serine protease.

Furthermore, according to Annex B, Part II, Example 17 of the Administration Instructions Under the PCT, the protein and the DNA encoding the protein share a special technical feature. Even if no technical feature is shared, according to Annex B, Part 1, Instructions Concerning Unity of Invention, in the section entitled "Combinations of Different Categories of claims", claims to a product, a method of making the product, and a method of using the product have unity of invention. Therefore, it is respectfully requested that all Groups be rejoined under PCT Unity of Invention Rules as relating to a single general inventive concept. At a minimum, Groups I, II, III, and V should be examined together.

Withdrawal of the restriction requirement is respectfully requested.

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The examiner has also required election of a single species to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicants elect the species of claim 42(a), a protein having the amino acid sequence composed of 229 amino acids represented by residues 1 to 229 of SEQ ID NO:2. The claims readable on the elected species are claims 1, 30-42, and 48-53. If Group II is rejoined with Group I under PCT Unity of Invention Rules, then applicants further elect the species of claim 43(bb), a nucleotide sequence encoding the amino acid sequence of residues 1 to 229 of SEQ ID NO:2.

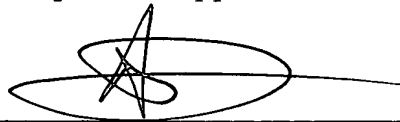
It is understood that upon allowance of a generic claim, applicants will be entitled to consideration of claims to additional species.

Favorable consideration is respectfully solicited.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicant(s)

By



Allen C. Yun  
Registration No. 37,971

ACY:pp  
624 Ninth Street, N.W.  
Washington, D.C. 20001  
Telephone No.: (202) 628-5197  
Facsimile No.: (202) 737-3528  
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